

REMARKS

To date, the Examiner has not indicated that all of the subject matter of the information disclosure statement (IDS) filed December 23, 2004, has been properly considered. A copy of such IDS, along with additional copies of the unconsidered references, is submitted herewith. If the Examiner requires additional copies of any reference(s), applicant invites the Examiner to contact the undersigned. Documentation in the file wrapper of the instant application confirming the Examiner's consideration of the relevant reference(s) is respectfully requested.

The Examiner has objected to Claims 11 and 37 due to informalities. Applicant has clarified such claims to avoid such objections.

The Examiner has further rejected Claims 1, 12, 18, 27, 38 and 44 under 35 U.S.C. 112, second paragraph. Applicant respectfully asserts that such rejections are moot in view of the clarifications made to Claims independent 1 and 27.

The Examiner has rejected Claims 1-12, 18-38 and 44-55 under 35 U.S.C. 102(e) as being anticipated by Vaziri et al. (U.S. Patent No. 6,377,570). Applicant respectfully disagrees with such rejection, especially in view of the clarifications made hereinabove to each of the independent claims.

With respect to independent Claims 1, 27 and 52, the Examiner has relied on the following excerpts from Vaziri to make a prior art showing of applicant's claimed "at least two connection ports, wherein the first port connects to an Internet conduit, and the second port connects to said Internet-ready device" (see Claims 1 and 27) and "a user interface block to connect to said Internet-ready device" (see Claim 52).

"Other than the user pressing a button (either on the ISB or telephone keypad) to initiate the Internet telephone call, the ISB takes care of all connection procedures (i.e., handshaking) necessary to set up and maintain the Internet telephone call. While both parties must possess an ISB in order to take advantage of the ISB's IT capabilities, only one party needs to initiate

the telephone call in order to establish the Internet connection, so that prearrangement is not required." (Col. 3, lines 33-37)

"FIG. 4 shows the back or bottom view of an ISB. Back or bottom panel 402 can include telephone jack 404 for connection to telephone 211, telephone jack 406 for connection to telephone line 212, optional port (serial, parallel, universal serial bus (USB), etc.) 408 for connection to another device such as a PC, and power jack 410." (Col. 12, lines 1-6; see also Figure 4)

Applicant respectfully asserts that the above excerpts from Vaziri simply relate to a telephone (item 211 of Figures 2B) that is not an "Internet-ready device," as claimed by applicant, since such device cannot connect to the Internet by itself. Furthermore, the Vaziri references even *teaches away* from applicant's specific claim language since Vaziri expressly states that the "[t]elephone 211 should preferably not be the sort of telephone which has its own power source (e.g., cordless telephone or integrated telephone and answering machine) or which manipulates its signaling (e.g., speaker phone with echo suppression technology)" (see Col. 9, lines 63-67), which suggests that the telephone 211 includes a conventional telephone that would not be Internet-ready.

With respect to independent Claims 1 and 27, the Examiner has relied on the following excerpts from Vaziri to make a prior art showing of applicant's claimed "having associated indicators to indicate to said user that said passing of information is complete" (see this or similar, but not identical language in each of the foregoing independent claims).

"FIG. 3 shows a front or top view of an ISB. Front or top panel 302 may include a logo 305. Status indicator LEDs 304, 306, 307 and 311 may be provided. Three of these LEDs may be used to indicate whether the power is on or off, the status of an Internet call attempt and whether any messages are waiting. The fourth can be used in various ways, such as to indicate whether the menu feature is in use or whether an upgrade to the ISB software is available (in which case the software can be upgraded in a manner to be described below). Of course, other configurations of LEDs can be used, as can other interfaces such as an alphanumeric LCD display." (Col. 11, lines 11-22)

Applicant respectfully asserts that the above excerpt from Vaziri only teaches that the LED's may indicate whether the power is on or off, the status of an Internet call

attempt, whether messages are waiting, whether a menu feature is in use and whether an upgrade is available. Clearly there is no disclosure or even suggestion of having indicators “to indicate to said user that said passing of information is complete” (emphasis added).

With additional reference to independent Claims 1 and 27, the Examiner has relied on the following excerpts from Vaziri to make a prior art showing of applicant’s claimed “protocol handler block for receiving and handling messages from said user interface and from said Internet-ready device, and for sending on said handled messages to a network stack block” (see this or similar, but not identical language in each of the foregoing claims).

“More specifically, the ISB stores device, server, billing, and owner information and a friends directory. The device information is typically programmed into the ISB at the factory and includes the serial number, the manufacturing date, the hardware version, the software version, and the feature key, which identifies those features which the ISB implements. The server information includes the IP addresses for the various servers which the ISB needs to access, such as the primary and backup ISBSSs. The owner information includes the telephone number, the ISP access telephone number, any scripting required to log onto the ISP, logon name and password, the domain names or IP addresses for the SMTP and POP servers for e-mail, the e-mail address, and the e-mail password.” (Col. 13, lines 13-25)

Applicant respectfully asserts that the above excerpt from Vaziri only relates to information with respect to the device, server, billing, owner information and friends directory that the Internet switch box (ISB) stores. In no way is there even a suggestion of any sort of messages, let alone sending handled messages to a network stack block, in the manner claimed by applicant.

Also with respect to independent Claims 1 and 27, the Examiner has relied on the following excerpts from Vaziri to make a prior art showing of applicant’s claimed “network stack block for handling an associated subset of said handled messages, and

sending on to a physical connection block" (see this or similar, but not identical language in each of the independent claims).

"Connection to the ISP will now be explained with reference to FIG. 7B. The modem is initialized, and telephone line 212 is monitored for a dial tone. ISB 100 dials the ISP access number to connect via PSTN 702 to modem rack 704 of the ISP. The modem of the ISB and a modem reached in modem rack 704 negotiate the baud rate and the protocol, whereupon ISB 100 is connected to the facilities of ISP 706. The ISB and the ISP perform any authentication procedure required, and the ISB selects "PPP" from the ISP's logon menu, if any. The ISB and the ISP then start communication by PPP, and PAP (the password authentication protocol) is carried out if no authentication has been performed before. The ISB is then connected by TCP to the ISP and thus via line 708, such as a T1 or T3 line or the like, to Internet backbone 710." (Col. 14, line 55-Col. 15, line 2)

After review of the above excerpt, it is clear that Vaziri is only teaching the method by which the phone is connected to the ISP. Thus, there is no mention of a subset of handled messages, a stack block, or a physical connection block, in the context claimed by applicant.

Nevertheless, despite the foregoing paramount distinctions and in the spirit of expediting the prosecution of the present application, applicant has clarified each of the independent claims to further distinguish the prior art of record. Specifically, applicant has amended each of the independent claims to include in part:

"at least two connection ports, wherein the first port connects to an Internet conduit, and the second port connects to said Internet-ready device capable of communicating utilizing Internet-related protocols;

a user interface, allowing said user to initiate passing information between said Internet-ready device and said Internet, and having associated indicators to indicate to said user that said passing of information that was initiated by the user is complete" (see the same or similar claim language in Claims 1 and 27); and

“a user interface block to connect to said Internet-ready device capable of communicating utilizing Internet-related protocols” (see Claim 52).

The Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

This criterion has simply not been met by the Vaziri reference, especially in view of the amendments made hereinabove. A notice of allowance or a specific prior art showing of each of the foregoing claimed features, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to dependent Claim 9 et al., the Examiner has relied on Col. 10, lines 26-28 of Vaziri to make a prior art showing of applicant’s claimed apparatus “whereby said apparatus is built to be embedded into other devices.” Applicant respectfully asserts that such excerpt simply discloses that “the ISB can alternatively be implemented with a DSP chip.” Simply implementing an ISB with a DSP chip does not meet any sort of embedding into other devices, as claimed by applicant.

The Examiner has further rejected Claims 13-17 and 39-43 under 35 U.S.C. 103(a) as being unpatentable over Vaziri in view of Martin et al. (“An Alternative to Government Regulation and Censorship: Content Advisory Systems for the Internet”).

With respect to dependent Claim 13 et al., the Examiner has relied on page 2, 4th paragraph in Martin to make a prior art showing of applicant's claimed "rating system, wherein said Internet-ready device passes a rating level to the Internet, whereupon only data not violating said rating level is passed back to said Internet-ready device." Upon reviewing such except, it is clear that it only generally discloses content-based and age-based advisory systems for video and computer games. However, the general description completely fails to even mention an "Internet-ready device [that] passes a rating level to the Internet" such that "only data not violating said rating level is passed back to said Internet-ready device" (emphasis added), as claimed by applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. A notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Still yet, applicant brings to the Examiner's attention the subject matter of new Claims 56-59 below, which are added for full consideration:

"wherein said Internet-ready device is embedded into an Internet-capable telephone" (see Claim 56);

“wherein said closure of said Internet permits an Internet connection only to a website specified by said Internet-ready device” (see Claim 57);

“wherein said Internet-ready device includes a toy which emits sounds that are updated utilizing said Internet” (see Claim 58); and

“wherein said Internet-ready device includes an electronic book” (see Claim 59).

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NVIDP322_P001314).

Respectfully submitted,
Zilka-Kotab, PC.

Kevin J. Zilka
Registration No. 41,429

P.O. Box 721120
San Jose, CA 95172-1120
408-505-5100